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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/554,052

01/24/2006

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EXAMINER

MARX, IRENE

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

09/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/554,052	Applicant(s) FARRELL ET AL.	
	Examiner Irene Marx	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) 1-35,49-70 and 72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-48 and 71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The application should be reviewed for errors. Error occurs for example, in the preliminary amendment to the specification filed 10/24/05 in the use of the term "nationalization". Error occurs also in the designation of a species as "Coriolus vesicular" in claim 71.

To facilitate processing of papers at the U.S. Patent and Trademark Office, it is recommended that the Application Serial Number be inserted on every page of claims and/or of amendments filed.

The substitute specification has not been entered because there is no indication that no new matter is added.

Applicant's election without traverse electing to prosecute the invention of Group IV, claims 36-48 and 71 on 6/6/08 is acknowledged.

Claims 36-48 and 71 are being considered on the merits. Claims 1-35, 49-70 and 72 are withdrawn from consideration as directed to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-48 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 is vague, indefinite, confusing and incomplete in the recitation of "preparation of a composition comprising or including decay fungi according to the above method" in that it is unclear what is intended by "above method" in the absence of dependence on a specific claim. The claim is also incomplete in that none of the "above claims" is elected.

Claim 36 encompasses the limitation "application ... to non-sterilized wood subsequently used for pulp production". It is unclear at which point the wood is "used for pulp production". This appears to be an intended use.

Also the claim appears redundant in the phrase "comprising or including".

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Claim 71 provides for the use of *Coriolus*, but does not set forth with any particularity how this pertains to the method of claim 36.

Claim 71 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 47-48 and 71 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The invention appears to employ a specific strains of *Coriolus* and *Pleurotus*. It is not clear if the written description is sufficiently repeatable to avoid the need for a deposit. Further it is unclear if the starting materials were readily available to the public at the time of invention.

It is not clear if a deposit that meets all of the criteria set forth in 37 CFR 1.801-1.809 has been made. Applicant or applicant's representative may provide assurance of compliance with the requirements of 35 U.S.C § 112, first paragraph, in the following manner.

SUGGESTION FOR DEPOSIT OF BIOLOGICAL MATERIAL

A declaration by applicant, assignee, or applicant's agent identifying a deposit of biological material and averring the following may be sufficient to overcome an objection and rejection based on a lack of availability of biological material.

1. Identifies declarant.
2. States that a deposit of the material has been made in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted. The depository is to be identified by name and address.
3. States that the deposited material has been accorded a specific (recited) accession number.

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4. States that all restriction on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent.
5. States that the material has been deposited under conditions that access to the material will be available during the pendency of the patent application to one determined by the Commissioner to be entitled thereto under 37 CFR 1.14 and 35 U.S.C § 122.
6. States that the deposited material will be maintained with all the care necessary to keep it viable and uncontaminated for a period of at least five years after the most recent request for the furnishing of a sample of the deposited microorganism, and in any case, for a period of at least thirty (30) years after the date of deposit for the enforceable life of the patent, whichever period is longer.
7. That he/she declares further that all statements made therein of his/her own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the instant patent application or any patent issuing thereon.

Alternatively, it may be averred that deposited material has been accepted for deposit under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the purpose of Patent Procedure (e.g. see 961 OG 21, 1977) and that all restrictions on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent.

Additionally, the deposit must be referred to in the body of the specification and be identified by deposit (accession) number, date of deposit, name and address of the depository and the complete taxonomic description.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 36-38, 40-43 and 46 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Blanchette *et al.* (Canadian Journal of Botany, (1978) Vol. 56, No. 22, pp. 2904-2909.)

The claims are drawn to a method of enhancing wood or wood products quality providing a composition of decay fungi and applying same to non-sterilized wood intended for pulp production.

Blanchette *et al.* disclose a method of enhancing wood or wood products quality providing a composition of decay fungi and applying same to non-sterilized wood intended for pulp production. See, e.g., page 2905, Materials and Methods.

Claims 36-38, 41-43 and 46 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wolfhaardt *et al.* (Biotechnology in the Pulp and Paper Industry: Recent Advances in Applied and Fundamental Research, Proceedings of the International Conference on Biotechnology in the Pulp and Paper Industry, 6th, Vienna, June 11-15, 1995 (1996), Meeting Date 1995, 211-216. Editor(s): Srebotnik, Ewald).

The claims are drawn to a method of enhancing wood or wood products quality providing a composition of decay fungi and applying same to non-sterilized wood intended for pulp production.

Wolfhaardt *et al.* disclose a method of enhancing wood or wood products quality providing a composition of decay fungi and applying same to non-sterilized wood intended for pulp production. See, e.g., page 212, paragraph 4-5.

Claims 36-38, 40-44 and 46 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Solar *et al.* (Drevarsky Vyskum (1998), 43(3-4), 29-37).

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The claims are drawn to a method of enhancing wood or wood products quality providing a composition of decay fungi and applying same to non-sterilized wood intended for pulp production.

Solar *et al.* disclose a method of enhancing wood or wood products quality providing a composition of decay fungi and applying same to non-sterilized wood intended for pulp production. See, e.g., page 30, Experimental.

Claims 36-48 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solar *et al.*, taken with Wolfhaardt *et al.*, Blanchette *et al.*, and Gutierrez *et al.* (Environmental Science and Technology (2000), 34(17), 3705-3709

The claims are drawn to a method of enhancing wood or wood products quality providing a composition of decay fungi and applying same to non-sterilized wood intended for pulp production.

Solar *et al.*, Wolfhaardt *et al.* and Blanchette *et al.* each discloses a method of enhancing wood or wood products quality providing a composition of decay fungi and applying same to non-sterilized wood intended for pulp production. See, e.g., Solar *et al.*, page 30, Experimental; Wolfhaardt *et al.*, page 212, paragraph 4-5 and Blanchette *et al.*, page 2905, Materials and Methods.

The references differ from the claimed invention in that the specific ratio of fungi to wood is not precisely as claimed and that the time of treatment is not disclosed as being 7 days. However, the adjustment of such process conditions for optimization purposes identified as result-effective variables cited in the references would have been prima facie obvious to a person having ordinary skill in the art, since such adjustment is at the essence of biotechnical engineering.

Regarding the specific strains recited, each of Blanchette *et al.*, Wolfhaardt *et al.* and Solar *et al.* disclose strains of *C. versicolor* which appear to be substantially similar to the presently claimed strains since they belong to the same species and are taught to be effective for the same purpose of treating wood for pulp production. In addition Gutierrez *et al.* teach a strain of *Pleurotus* which has similar properties. See, e.g., Methods.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the processes of Blanchette *et al.*, Wolfhaardt *et al.*

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and Solar *et al.* by using other ratios of inoculation for the *C. versicolor* fungi and adjusting the time of treatment to 7 days as well as using a variety of strains of *C. versicolor* as suggested by the teachings of Blanchette *et al.*, Wolfhaardt *et al.* and Solar *et al.* and/or a strain of *Pleurotus* as disclosed by Gutierrez *et al.* for the expected benefit of maximizing the pretreatment of wood to produce pulp having improved quality and lower kappa numbers.

Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Irene Marx/
Primary Examiner
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